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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,914	04/05/2004	Toru Wada	358362010601	2618

7590 10/06/2005

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EXAMINER	
HAMILTON, CYNTHIA	
ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/816,914	WADA ET AL.	
	Examiner	Art Unit	
	Cynthia Hamilton	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *18-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 10/279005.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The examiner notes for the record that United States Application No. 11/159,210 has a filing date of June 23, 2005 which is after the mailing date of June 14, 2005 of the last Office action in this application. Thus, no rejection was available to be made in view of this application. It is the filing of a third application by applicants that requires the new rejection in this application.

2. The terminal disclaimer filed on June 14, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 10/279,005 has been reviewed and is accepted. The terminal disclaimer has been recorded.

3. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claim 23 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 16 of copending Application No. 11/159,210. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

6. Claims 18-22 and 24-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-31 of copending Application No. 11/159,210. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the element in the copending application by presenting claim 19 makes obvious the use of the non-IR sensitive polymer resin layer between the IR absorbent metal layer and the cover film for the laminate claimed to have a narrower range of optical density than that of instant claims 18-22 and 24-31. Thus, the element of claim 19 of 11/159,210 anticipates the element of instant claim 18. With respect to further limits set on the metal layer, the claims 16-18 and 20-27 of 11/159,210 make obvious such modifications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Being able to determine specific values for (D) and (C) is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The examiner notes with respect to instant claim 9 that applicants on pages 20-21 define the definition of "rate of change in the radius of a halftone dot after IR ablation". The variable A is the half tone dot radius when (D), i.e. a certain value of laser energy is irradiated and B is the halftone dot radius when a laser energy value is changed to an optional value (C). This is the basis for claim 24 wherein there is no defining of the specific laser energy used for (D) or (C). Thus, applicants have not enabled a worker of ordinary skill in the art to determine when the unimaged unablated photosensitive resin laminate has the properties set forth by "rate of change in the radius of a halftone dot after IR ablation" because applicants have not made clear what (C) and (D) reference with regard to an unimaged, unablated laminate. Since the use of different lasers, speed of rotation of the cylinder being imaged, distance from plate by and time used of the laser effect these properties

of dot size, the exact set of testing parameters for an un imaged un ablated plate would be necessary for a worker of ordinary skill in the art to determine if the plates they intended to use would read on applicants laminates. Thus, the "rate of change in the radius of a halftone dot after IR ablation" is an intended property as now defined for some system in which their laminate could be used. The examiner does not see how the "rate of change in the radius of a halftone dot after IR ablation" is an absolute of any laminate as a melting point is for a compound. Thus, how this test relates to an unimaged plate without knowing what lasers for (C) and (D) are chosen is non-enabling for this test in claim 24.

8. Applicant's arguments filed June 14, 2005 have been fully considered but they are not persuasive. With respect to instant claim 24, Applicants have not stated that the value obtained is inherent in the element claimed. Applicants do not show that the element has a specific property "rate of change in the radius of a halftone dot after IR ablation" for any choice of laser for (C) and (D) under any process conditions. The rejection stands.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The examiner notes that because applicant filed the third application in this series of applications after the date of the first mailed office action this does not remove the requirement that the Examiner make this application final under the procedures set forth in MPEP 708.02 for all applications made SPECIAL as this application has been made.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331. The examiner can normally be reached on Monday through Friday 9:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571) 272-0729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cynthia Hamilton
Primary Examiner
Art Unit 1752

CYNTHIA HAMILTON
PRIMARY EXAMINER

October 3, 2005